AF/3711

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#14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

John SKALEN

Serial No.: 09/787,750

Filed: May 21, 2001

For: GOLF TRAINING DEVICE

Date: February 26, 2003

Group Art Unit: 3711

Examiner: M. Chambers

Asst. Commissioner for Patents

Washington, D.C. 20231

APPEAL BRIEF PURSUANT TO 37 C.F.R. §1.192

Sir:

This Appeal concerns the propriety of the Examiner's final rejection dated June 28, 2002, in connection with the above-identified application. The Notice of Appeal was filed on December 27, 2002.

STATUS OF CLAIMS:

Claims 6-11 are pending and on appeal herein.

REAL PARTY IN INTEREST:

The real party in interest is the assignee, Homerange AB, a Swedish Corporation.

RELATED APPEALS AND INTERFERENCES:

The applicants, the assignee and the undersigned attorneys are not aware of any related appeals or interferences.

STATUS OF AMENDMENTS:

By an Amendment pursuant to 37 C.F.R. §1.116 dated December 17, 2002, Applicant proposed to correct a possible ambiguity in claims 6-8 and 10, and to clarify the language by which

certain features of the invention were recited in claim 6. In an Advisory Action dated December 26, 2002, the Examiner refused to enter the amendment on the ground that it purportedly raised new issues. Accordingly, the claims on appeal as set forth in Appendix A hereto are as pending at the time of the final rejection. The proposed amendments to claims 6-8 and 10 submitted pursuant to 37 C.F.R. § 1.116, with the proposed deletions bracketed and the proposed additions underlined appear in Appendix B. Applicant considers the claims as finally rejected to be patentable, but would be prepared to amend claims 6-8 and 10 as indicated in Appendix B should the Board make a recommendation to that effect pursuant to 37 C.F.R. § 1.196(c).

SUMMARY OF THE INVENTION:

The present invention is directed to an improved practice device for the game of golf. Broadly stated, as illustrated in the single drawing figure, the device is comprised of a golf ball 1 tethered at one end 2 of a non-resilient rope or line 3[1], the opposite end 4 of which is anchorable in the ground, and a resilient line 7 which is anchorable to the ground at both ends 8 and 9, and which is coupled to the non-resilient line by a ring 6 slidable freely on both lines.

An important feature of the invention is a set of reference marks or indicators on the non-resilient line, e.g., a succession of differently colored areas A-C. These are used during installation to assure proper operation with different golf clubs. For this purpose, the resilient line 7 is anchored, with ring 6 located approximately centrally thereon. The non-resilient line is then positioned with the reference mark corresponding to a club with which the user intends to practice located at the ring, and the free end 4 of the non-resilient line is anchored. This determines the rest position of the ball relative to the resilient line: for example, in the case of an iron, the rest position will be closer to the resilient line than for a wood. Alternatively, of course, the non-resilient line can be anchored first, and the resilient line thereafter positioned so that it intersects the non-resilient line at the desired reference mark.

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1. As indicated in the Appendix hereto, the claims as finally rejected referred to this line as "rigid". Applicant proposed to replace this with the term "non-resilient" in the Amendment under 37 C.F.R. § 1.116, but the Examiner refused to enter this amendment, and several others on the ground that they raised new issues requiring "further considerations and/or new search".

ISSUE TO BE DECIDED IN THIS APPEAL:

Whether claims 6-11 are unpatentable under 35 U.S.C. §103(a) as being obvious over Widnall (British Patent 401,955) in view of Deane (U.S. Patent No. 3,122,369).

GROUPING OF CLAIMS:

All of Claims 6-11 stand or fall together.

ARGUMENT:

The Prior Art

Both of the references disclose golf training devices. The device shown in Fig. 1 of the Deane patent has structural and operational similarities to that of the present invention, but the structure of Widnall's device is quite different. Fig. 1 of Deane shows an inelastic tether or cord 5 with a golf ball 3 attached at one end. The other end is anchored in the ground by a stake 6. Running cross-wise to cord 5 is an elastic line 8 anchored by stakes 9, and connected to cord 5 by a pair of connected loops 11 and 12.

The only indicia disclosed in the Deane patent is part of a device for registering apparent ball travel distance. This is comprised of a tape 11 graduated in units of distance which rests under cord 5. An associated bead 11a slides on cord 5. When the ball is struck, bead 11a travels along cord 5 a distance determined by the force of the drive, and thus indicates the length of the drive by its position along tape 11.

There is no teaching or suggestion that elements 11 and 11a have (or can have) any function relating to selection of the crossing point between cord 5 and line 8, whether to facilitate use of the device with different golf clubs, or for any other purpose.

Widnall's device is comprised of a first elastic line 8 anchored to the ground at one end by a stake 5. The other end passes through a lower loop 11 of a swivel mechanism 9, and a loop 7 of a second stake 6, and is secured to an upper loop 10 of swivel mechanism 9. A second elastic line 12 is attached to a ball 13 at one end, and to swivel loop 10 at the other end.

Widnall also shows a travel distance indicator. This is comprised of an indicator piece 15 which slides along cord 8, i.e., the one *not attached to the ball*, and markers 16-19 also on cord 8. When the ball is hit, indicator 15 travels a distance determined by the extension of line 8, and its rest position relative to the reference markers after the drive indicates the apparent travel distance.

As in the case of Deane, there is no teaching or suggestion in Widnall that indicator 15, and reference markers 16-19 have, or can have, any function relating to selection of the crossing point of cord 12 relative to cord 8 to facilitate use with different golf clubs, or for any other purpose. Indeed, it is not even possible to achieve such function in Widnall, as lines 8 and 12 do not cross.

The Examiner's Position

In the final Office Action, claims 6, 7, and 11 were rejected as obvious over Deane in view of Widnall. According to the Examiner, Deane discloses all the features of the invention except for "indicia placed on the tether" i.e., the non-resilient line, which are shown in Widnall. In the Examiner's opinion, adding Widnall's indicia to Deane's non-resilient line would have been obvious "in order to reduce the manufacturing cost and reduce the number of sub-components of the apparatus.

The Examiner appears to have recognized that the distance indicators of the prior art do not serve the same function as in the present invention, because he states in the final rejection that "...phrases in the claim directed to the intended manner of use of the device cannot be used to distinguish over prior art disclosing the structure."[2]

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2. In responding to arguments made by applicant's representative during a telephone interview on December 20 , 2002, the Examiner appears to have taken the position that if Deane's description of his indicia 11 is read broadly, it would support a rejection under 35 U.S.C. §102(b). Applicant is uncertain if the Examiner has changed the statutory basis for the rejection, but it would seem that if the Examiner proposes to reject any of the claims as anticipated by Deane, the final rejection should have been withdrawn, the amendment entered, and the new rejection presented directly in a way that it could be dealt with fairly. In any event, as demonstrated below, neither the actual final rejection under 35 U.S.C. §103, nor one under 35 U.S.C. §102(b) is proper.

Analysis of the Final Rejection

In essence, it is applicant's position that the Examiner has applied an incorrect rule for determining patentability of an invention involving the relationship of structure and associated indicia or printed matter.

Printed matter is considered non-statutory, and therefore not patentable *per se*. That does not, however mean that a claimed functional relationship between printed matter and structure can be ignored in determining patentability of a claimed combination of elements including printed matter ***In re Miller,*** 57 CCPA 89, 418 F.2d 1932, 164 U.S.P.Q. 46, 49 (CCPA 1969).

In his rejection of claim 6, the Examiner has impermissibly ignored the function of the indicia or markings A-C on applicant's non-resilient line 2 as directing the positioning of line 2 and relative to line 7 which is in fact a distinguishing feature of the present invention over the prior art. He does this by dismissively characterizing as a statement of an "intended manner of use" the recitation in claim 6 of:

> a plurality of marks located on said rigid line wherein a mark indicates a reference point for said resilient line to transverse said rigid line and said mark indicates a type of a golf club for a player to use when said resilient line crosses said rigid line at said mark[3]

By ignoring the claimed function of markings A-C, or by treating it as an irrelevant statement of intended use - which amounts to the same thing- the Examiner has relied on a doctrine which, if it was ever good law, no longer has a statutory basis, has been discredited judicially at least

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3. The corresponding recitation in claim 6 according to the proposed Amendment under 37 C.F.R. §1.116 reads:

> a plurality of indicators located on said non-resilient line each indicator representing a location at which said resilient line is to cross said non-resilient line when the first and second ends of said resilient line are anchored to the ground for correct operation of the device with a particular type of a golf club.

as early as 1969 in ***In re Miller, id.,*** and even more recently in ***In re Gulack,*** 703 F.2d 1381, 217 U.S.P.Q. 401 (CAFC 1983). Here, the Court, relying on ***Miller,*** stated that:

> Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole (citations omitted) . . . The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate" ***In re Gulack*** at 303, 404.[4]

There is clearly a novel functional relationship between applicant's indicia A-C and his lines 2 and 7 as compared to the functional relationship between tape 11 and bead 11a in Deane. As seen in the limitation of claim 6 quoted above, the markers permit proper setup of the device for use with different clubs. In Deane, tape 11 and bead 11a serve only to register an apparent distance of travel.[5]

Thus, when the quoted limitation of claim 6 is given proper consideration in the claimed combination, it is clear that novelty is present. Nor is the claimed functional relationship obvious from the teachings of Deane or Widnall, whether considered alone or in combination. The idea of setting up the prior art devices differently in accordance with the club to be used is never mentioned or suggested in either reference.

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4. In Footnote 8, the Court in ***Gulack*** explained that a "printed matter rejection" is based on case law antedating the 1952 patent act, employing a point of novelty approach, and is no longer valid under 35 U.S.C 103 which requires that a claim be viewed as a whole in determining obviousness. Moreover, the Court, referring to ***In re Royka,*** 490 F.2d 981, 180 USPQ 580 (CCPA 1974), stated that "the CCPA, notably weary of reiterating . . . [that all limitations must be considered] . . . clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated."

5. The marks 16-19 and indicator 15 in Widnall serve exactly the same purpose as those in Deane.

Patentability of Claims 7-11

As these claims are all dependent on claim 6, they are patentable for at lest the reasons stated above.

CONCLUSION:

It has been clearly demonstrated that the rejections of claims 6-11 are based on an improper disregard by the Examiner of a claimed functional relationship between lines 2 and 7 and the markings A-C used to position lines 2 and 7 relative to each other for use with different golf clubs.. It has also been demonstrated that the claimed functional relationship is not taught or suggested in the prior art, and is therefore both novel and unobvious. Accordingly, when the recited functional relationship is given proper consideration in combination with the recited structural elements of the claims as required by ***In re Miller*** and ***In re Gulack, supra***, it is clear that the claimed invention as a whole is patentable over the prior art of record. It is therefore respectfully requested that the decision of the Examiner finally rejecting claims 6-11 be reversed and that this application be passed to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, on February 26, 2003:

Lawrence A Hoffman
Name of applicant, assignee or Registered Representative

Signature

February 26, 2003
Date of Signature

LAH:sks

Respectfully submitted,

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APPENDIX A

CLAIMS ON APPEAL

6. A golf swing training device comprising:

a golf ball;

a rigid line wherein a first end of said rigid line is secured to said golf ball and a second end of said rigid line is anchored to the ground at a predetermined distance in front of said golf ball;

a resilient line that is transverse to said rigid line and approximately bisected by said rigid line, said resilient line has both a first end and a second end anchored to the ground;

a ring that encloses said rigid line and said resilient line, wherein said ring is slidable along said rigid line and said ring is slidable along said resilient line; and

a plurality of marks located on said rigid line wherein a mark indicates a reference point for said resilient line to transverse said rigid line when the first and second ends of said resilient line are anchored to the ground for correct operation of the device with a particular and said mark indicates a type of a golf club for a player to use when said resilient line crosses said rigid line at said mark

7. The golf swing training device of claim 6, wherein a length of said rigid line is approximately seven meters and a length of said resilient line is approximately five meters.

8. The golf swing training device of claim 6, wherein said rigid line is secured to said golf ball by an expansion means or a holding ring that is coupled to a corrugated fastener member located at a core of said golf ball.

9. The golf swing training device of claim 8, wherein said golf ball comprises a mounting hole with a greater diameter at an outer shell of said golf ball than at a center of said golf ball.

10. The golf swing training device of claim 6, wherein said rigid line is secured to said golf ball by a vulcanization process.

11. The golf swing training device of claim 6, wherein said golf swing training device controls a return of said golf ball and prevents said golf ball from reaching said player.

APPENDIX B

PROPOSED AMENDMENTS UNDER 37 C.F.R. 1.116

6. A golf swing training device usable with diverse golf clubs comprising:

a golf ball;

a [rigid] non-resilient line wherein a first end of said [rigid] non-resilient line is secured to said golf ball and a second end of said [rigid] non-resilient line is anchored to the ground at a predetermined distance in front of said golf ball;

a resilient line that is transverse to said [rigid] non-resilient line and approximately bisected by said [rigid] non-resilient line, said resilient line has both a first end and a second end anchored to the ground;

a ring that encloses said [rigid] non-resilient line and said resilient line, wherein said ring is slidable along said [rigid] non-resilient line and said ring is slidable along said resilient line; and

a plurality of [marks] indicators located on said [rigid] non-resilient line each indicator representing a location at which [wherein a mark indicates a reference point for] said resilient line [to transverse] is to cross said [rigid] non-resilient line when the first and second ends of said resilient line are anchored to the ground for correct operation of the device with a particular [and said mark indicates a] type of a golf club[for a player to use when said resilient line crosses said [rigid] non-resilient line at said mark]

7. The golf swing training device of claim 6, wherein a length of said [rigid] non-resilient line is approximately seven meters and a length of said resilient line is approximately five meters.

8. The golf swing training device of claim 6, wherein said [rigid] non-resilient line is secured to said golf ball by an expansion means or a holding ring that is coupled to a corrugated fastener member located at a core of said golf ball.

10. The golf swing training device of claim 6, wherein said [rigid] non-resilient line is secured to said golf ball by a vulcanization process.